

REMARKS

Claims 1-9 are currently pending in the instant application.

In the Office Action, the Examiner rejects claims 1-9 under 35 U.S.C. §103(a), as being obvious over U.S. Patent Application Publication No. 2002/0115565 of Asrar, *et al.* (“Asrar”) in view of U.S. Patent No. 6,218,416 of Sembo (“Sembo”). Specifically, the Examiner contends that Asrar discloses a method of controlling pests with an insecticidal composition that contains an oxadiazine derivative and a pyrethroid compound, namely imiprothrin, and which has a ratio of oxadiazine to imiprothrin of between 1:1000 to 1000:1. The Examiner acknowledges that Asrar fails to specifically teach indoxacarb as the oxadiazine derivative. However, in an effort to address this shortcoming of Asrar, the Examiner inaccurately contends that Sembo discloses a method of controlling pests with a composition containing a guanidine derivative, an oxadiazine compound and a pyrethroid compound. The Examiner argues that it would have been *prima facie* obvious to one of ordinary skill in the art to modify the insecticidal composition of Asrar to include indoxacarb and imiprothrin “as reasonably suggested by [Sembo].” (*See*, the Office Action, pages 3-4). On this basis, the Examiner contends that the claimed invention is obvious in view of Asrar in combination with Sembo. Applicant respectfully traverses the Examiner’s rejection and the arguments and contentions set forth in support thereof for at least the following reasons.

First, neither cited reference teaches or suggests a pesticidal composition that comprises an oxadiazine of the general formula (A) and an ester compound of the general formula (B), as claimed. Second, there is no teaching or suggestion in either reference which would motivate one of ordinary skill in the art to make the modifications suggested by the Examiner in order to arrive at the claimed composition. Third, one of ordinary skill in the art would have no reasonable expectation of successfully making such a modification and substitution, especially in the absence of any teaching or suggestion to do so. Thus, Applicant submits that the combination of Asrar and Sembo fails to satisfy the requirements necessary to establish a *prima facie* case of obviousness. Finally, even if one were to assume that a *prima facie* case of obviousness could be established on the basis of the combination of Asrar and Sembo, which it cannot, Applicant respectfully submits that any such *prima facie* case of

obviousness is sufficiently rebutted by the evidence of unexpected results (*i.e.*, a synergistic effect) observed for the claimed composition, as set forth in the Specification, *e.g.*, in Example 1.

As explained in Applicant's Response filed on December 8, 2005, the claimed oxadiazine compound of the formula (A) is a 1,3,4-oxadiazine ring-based structure. In contrast, Asrar is directed to insecticides which contain a neonicotinoid and a pyrethroid. The neonicotinoids of Asrar are NOT the same as the oxadiazine compounds of the present invention. Again, as explained in Applicant's Response of December 8, 2005, oxadiazine is a very broad term of nomenclature that encompasses any heterocyclic ring structure having two nitrogen atoms and one oxygen atom. However, the neonicotinoids of Asrar are structurally and functionally different than the oxadiazines of claimed formula (A). There is no teaching or suggestion in Asrar (or any other art of record or known to Applicant) which would motivate one of ordinary skill in the art to substitute a 1,3,4-oxadiazine compound for the neonicotinoids disclosed in Asrar.

Sembo, which is directed to pesticidal compositions that contain a guanidine compound and imiprothrin as active ingredients, mentions that suitable additional ingredients, such as pest repellants, may be included. Among many possibilities disclosed as suitable pest repellants which may be included in the guanidine compositions of Sembo, indoxacarb is mentioned. However, there is no teaching or any other disclosure in Sembo which suggests a specific active combination of indoxacarb and imiprothrin.

Moreover, there is nothing in either reference which would motivate one of ordinary skill in the art to act in direct contradiction of the express teachings of Asrar by substituting the optional pest repellent indoxacarb of the Sembo reference for the required neonicotinoid insecticide of Asrar. As explained above and in Applicant's prior Response, the Asrar neonicotinoids and indoxacarb are different classes of compounds. Thus, given the different chemical classification of the neonicotinoids of Asrar and the indoxacarb mentioned in Sembo as an optional pest repellant, it cannot reasonably be said that one of ordinary skill in the art would have an expectation of successfully substituting indoxacarb for the neonicotinoid active ingredient of Asrar. There is simply no teaching or suggestion in either reference which

would motivate one of ordinary skill in the art to make such a combination, substitution and modification, in order to arrive at Applicant's claimed invention.

Accordingly, since there is no teaching or suggestion of each and every element, nor a motivation to combine and modify the references, nor a basis for a reasonable expectation of success in doing so, it is submitted that the combination of references fails to satisfy the criteria necessary for establishing a *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) are respectfully requested.

Even assuming for argument's sake, that some motivation exists for combining and modifying the references as suggested by the Examiner to arrive at the claimed invention, which it does not, Applicant submits that the evidence set forth in the Specification's Examples sufficiently rebuts any such *prima facie* case of obviousness by clearly establishing unexpected advantages of the claimed invention in the form of a synergistic effect achieved by the claimed combination.

Specifically, for example, in Test Example 1, which begins at line 20 on page 9 of the Specification, the mortality percentage rates (*i.e.*, kill rates) for cockroaches treated with a composition containing Indoxacarb MP, a composition containing imiprothrin, and an inventive composition containing both Indoxacarb MP and imiprothrin were compared. The results of the comparison are set forth in Table 1 on page 10 of the Specification. As can be seen from the percentage mortality column in Table 1, the composition containing imiprothrin alone had a 0 % kill rate. The composition containing only Indoxacarb MP had a 25% kill rate. Surprisingly, a synergistic effect was observed for an inventive combination comprising Indoxacarb MP and imiprothrin, wherein the kill rate was 100%. It is respectfully submitted that the evidence of the unexpected synergistic effect achieved by the claimed combination as set forth, for example, in the Specification's Test Example 1, sufficiently rebuts any alleged *prima facie* case of obviousness that could arguably be established upon the combination of Asrar and Sembo. Accordingly, withdrawal of the rejection is respectfully requested.

Application No. 10/770,886
Reply to Office Action of March 22, 2006

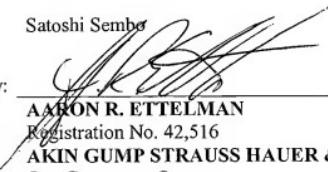
In view of the remarks set forth herein, Applicant respectfully submits that all pending claims patentably distinguish over the prior art of record and known to Applicant. Reconsideration, withdrawal of the rejection and a Notice of Allowance are respectfully requested.

Respectfully submitted,

Satoshi Sember

June 30, 2006
(Date)

By:


AARON R. ETTELMAN

Registration No. 42,516

AKIN GUMP STRAUSS HAUER & FELD LLP

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103-7013

Telephone: 215-965-1200

Direct Dial: 215-965-1240

Facsimile: 215-965-1210

E-Mail: aettelman@akingump.com

ARE:rc

Enclosure – Petition for Extension of Time (one month)